

Appl. No. 10/038,575
Amendment dated October 21, 2003
Reply to Office Action of July 21, 2003

Remarks

Claims 1-3, 5-25 and 26-48 are pending in the application, with claims 1, 24, 37, 40, 42, 44, 47 and 48 being the independent claims. Claims 4 and 25 have been canceled.

Based on the present Amendment and the following Remarks, Applicant respectfully requests that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Allowable Subject Matter

The indication that claim 26 contains allowable subject matter is gratefully noted. Claim 26 has been rewritten in independent form as new claim 47, including the features of the base claim 24 and intervening claim 25. Accordingly, claim 47 is in condition for allowance.

Rejections under 35 U.S.C. §103

Claims 1-25 and 27-44 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,830,126 to Ringe ("Ringe") in view of U.S. Patent No. 5,217,424 to Pallmann ("Pallmann") or U.S. Patent No. 975,563 to Morgan ("Morgan").

Initially, it is noted that the Action rejects 43 separate claims in less than one page. The Action fails to describe how the primary or secondary references relied upon teach virtually any of the claimed features. As such, it is difficult for the Applicant to have a fair opportunity to respond to the rejection. Clarification and an explanation of how the references teach each of the claimed features are respectfully requested. (See MPEP 706.02(j): "It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.")

1. Ringe does not teach a cutter with a knife blade that can be exchanged.

Col. 5, lines 9-19 of Ringe states: "The cutoff 21 further comprises a substantially cylindrical streamlined housing 27 for a holder 26 which supports a knife 28. The housing 26 rotates

in the direction indicated by the arrow and the holder 26 for the knife 28 is mounted in such a way (by one or more universal joints and in a manner known from the art of cutoffs for cigarette rods or the like) that the orbiting knife 28 has a component of movement in the direction indicated by the arrow 32 at the time its cutting edge severs the rod 19 in the space between two coaxial tubes 29, 31 of the guide 22." Thus, only a passing, parenthetical reference of how the holder is mounted is disclosed in Ringe. There is no teaching that the holder is discrete and exchangeable, and more importantly, there is no teaching at all about discrete and exchangeable knife blades or that the knife blades can be replaced at all. In other words, Ringe fails to disclose that the knife blades are replaceable even manually.

Accordingly, the rejection based on Ringe is improper and should be withdrawn because Ringe cannot be modified as proposed.

The Action argues that "It is inherent that the knives [of Ringe] are discrete and exchangeable."

2. Ringe fails to support an obviousness rejection based on inherency.

Attention is respectfully drawn to MPEP §2112, entitled "REQUIREMENTS OF REJECTIONS BASED ON INHERENCY; BURDEN OF PROOF," which states: "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. Ap. & Inter. 1990)." (emphasis in original). MPEP §2112 also states: "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993)." (emphasis in original). In the present case, the Action has failed to demonstrate that the knives would necessarily be discrete and exchangeable. Moreover, it is respectfully submitted that the knives do not, in fact, have to be discrete and exchangeable, particularly in view of the scant description in

Ringe. For example, the knives can be integral with the housing and replaced in connection with the housing. This possibilities alone renders a rejection based on inherency improper.

3. Knife blades that can be unlocked and replaced are not obvious.

Regardless of whether the knives in Ringe can be removed or not, the Action proposes that making a formerly integral structure in various elements involves only routine skill in the art and relies on *Nerwin v. Erlichman*, 168 USPQ 177, 179 (BPI 1969). However, the reliance on Nerwin is misplaced. Nerwin actually states: “The mere fact that a given structure is integral does not preclude its consisting of various elements.” *Id.* Thus, Nerwin does not state that providing a formerly integral structure in various elements involves only routine skill in the art. Instead, Nerwin merely states that being integral does not *preclude* a reading of the prior art of something with various elements.

In any event, the recitations of the independent claims are distinguishable and advantageous over the prior art, rendering an argument about “routine skill” faulty. As compared with the prior art, the present claimed invention is advantageous in that individual knives can be replaced instead of replacing entire holders of knives.

As such, the cited prior art fails to teach or suggest a severing apparatus that can be unlocked and removed. Particularly, Ringe fails to teach a “manual knife changing method” as suggested by the Action. As noted above, Ringe teaches an apparatus whereby the entire holder is replaced.

The Action proposes to modify the apparatus of Ringe with the “automated changing devices” of Morgan or Pallman.

3. Morgan and Pallman are non-analogous art with respect to the present invention and Rinke, and thus, should not be relied upon as a basis for rejection of the Applicant’s invention.

To be considered analogous art, the references must either be in the field of the Applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention

was concerned. Morgan is directed to a bit changing apparatus for mining machines, wood-working machinery, and metal-working tools, and Pallman is directed to wood flaking machines. Thus, it is clear that the cited references are not within the field of the Applicant's endeavor, i.e., manufacturing tobacco products.

Furthermore, the disclosures of Morgan and Pallman are not reasonably pertinent to any particular problem with which the invention was concerned.

It is noted, in this context, that exchanging or replacing knife blades, without regard to the type of apparatus, is an impermissibly and unreasonably broad statement of the "problem." It is unreasonable to argue that a person of ordinary skill in the art, seeking to automate the replacement of knives for severing a smokers' product, would look to the wood-working machinery of Morgan or the wood flaking machines of Pallman. The apparatuses are simply too different. In *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1993), the Federal Circuit rejected the PTO's argument that all hooking and fastener problems were analogous and stated that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would not reasonably be expected or motivated to look to fasteners for garments. See MPEP 2141.01(a). Similar to the situation of *Oetiker*, all cutting problems are also not analogous.

Furthermore, as noted by the Court of Appeals for the Federal Circuit on this issue:

"A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obvious rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would have accordingly have had less motivation or occasion to consider it."

In this regard, a person having ordinary skill in the art would not reasonably have expected to solve problems associated with severing tobacco products by considering a reference dealing with replacing drill bits or a reference dealing with wood flaking. There is no similar purpose.

4. Even if one does consider Morgan and/or Pallman to be analogous art, one would not combine Morgan or Pallman with Ringe in the manner proposed by the Action.

First, as discussed above, Ringe does not teach to manually replace the knife blades. Thus, it cannot be obvious to automate the replacement of the blades.

Moreover, even if Morgan and Pallman are considered analogous art, the differences in the apparatuses would factor in the determination of whether one would be motivated to combine the references as proposed. Applicant understands that the test for obviousness is not whether the features of the secondary reference can be bodily incorporated into the structure of the primary reference. (MPEP 4145). However, it is difficult to conceive how even the teachings of Morgan or Pallman can be incorporated into the apparatus of Ringe. Clarification is respectfully requested on how the specific teachings of Morgan or Pallman would be incorporated into the specific apparatus of Ringe.

5. The cited prior art, individually or in combination, fail to disclose “automatically unlocking the knife,” as recited in claims 4, 37 and “automatically locking,” as recited in claims 11, 22, 40. Clarification is respectfully requested.

Finally, as stated above, the Action fails to state how the cited references teach the features of the dependent claims. It is respectfully submitted that many of the dependent claims are separately allowable over the prior art. Clarification is respectfully requested.

Accordingly, for the reasons discussed above, claims 1-3, 5-25 and 26-48 are allowable.

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New claim 48

New claim 48 is a combination of claims 1, 2 and 4, and recites "removing the first knife from the holder by grasping the cutting edge of the first knife...". Pallmann and Morgan each fail to teach this feature. Both Pallman and Morgan push the knife out of the holder. (see Pallmann, col. 9, lines 22-44 and Morgan, col. 4, lines 118-130).

Conclusion

All of the stated grounds of objections and rejections have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicant believes that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

A Notice of Allowance with claims 1-3, 5-25 and 26-48 is respectfully requested.

Respectfully submitted,



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